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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,217	12/21/2001	Eric N. Olson	UTSD:695US	3415
7590	12/13/2004			
Steven L. Highlander Fullbright & Jaworski L.L.P. Suite 2400 600 Congress Avenue Austin, TX 78701			EXAMINER WAX, ROBERT A	
			ART UNIT	PAPER NUMBER
			1653	
DATE MAILED: 12/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/029,217

**Applicant(s)**

OLSON ET AL.

**Examiner**

Robert A. Wax

**Art Unit**

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2004 and 20 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-126 is/are pending in the application.
- 4a) Of the above claim(s) 44-80 and 82-126 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4,16,17,23,26-34 and 37-43 is/are allowed.
- 6) ☒ Claim(s) 2,5-15,18-22,35,36 and 81 is/are rejected.
- 7) ☒ Claim(s) 3,24 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>two of them</u> . | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 44-80 and 82-126 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the replies filed on June 30, 2004 and September 20, 2004.

### ***Information Disclosure Statement***

2. The information disclosure statements filed May 13, 2002 and April 22, 2003 have been considered. Please see the attached initialed PTO-1449.

### ***Claim Rejections - 35 USC § 112, Second Paragraph***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 18-22, 35, 40, 42 and 81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 contains the misspelled word, "polymucleotide".

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Claims 18-22 are substantial duplicates of claims 7-11, respectively, because claim 5, from which all these claims ultimately depend, already recites "contiguous".

Claim 35 contains the misspelled word, "cassett".

Claim 81 recites "host cells" in the body of the claim whereas the preamble recites "host cell"; agreement is required.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claim 5 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by GenBank AC005358.

GenBank AC005358 teaches a DNA sequence that is identical to 935 contiguous nucleotides of SEQ ID NO: 27; see the alignment provided with the copy of the reference.

8. Claims 5-15 and 18-22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Tang et al.

Tang et al. teach SEQ ID NO: 863 which encodes segments of instant SEQ ID NO: 28. At column 6, lines 36-52, they teach lengths of desired segments, which include those claimed. This clearly anticipates the claims.

9. Claim 5 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by GenBank AI607474.

GenBank AI607474 teaches a DNA sequence that is identical over 34 nucleotides (bases 1-34 of the database sequence).

10. Claims 6-15 and 18-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GenBank AC005358.

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GenBank AC005358 teaches a DNA sequence that is identical to 935 contiguous nucleotides of SEQ ID NO: 27; see the alignment provided with the copy of the reference. The claims are anticipated because the teaching of the entire sequence places all fragments in possession of the public. Alternatively, It would have been obvious to one of ordinary skill in the art at the time the invention was made to cleave the sequence taught by GenBank AC005358 into fragments of various sizes in order to use them as probes or primers since such cleaving is well known.

11. Claims 6-9 and 18-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GenBank AI607474.

GenBank AI607474 teaches a DNA sequence that is identical over 34 nucleotides (bases 1-34 of the database sequence). The claims are anticipated because the teaching of the entire sequence places all fragments in possession of the public. Alternatively, It would have been obvious to one of ordinary skill in the art at the time the invention was made to cleave the sequence taught by GenBank AI607474 into fragments of various sizes in order to use them as probes or primers since cleaving for such purposes is well known.

***Allowable Subject Matter***

12. Claims 3, 24 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

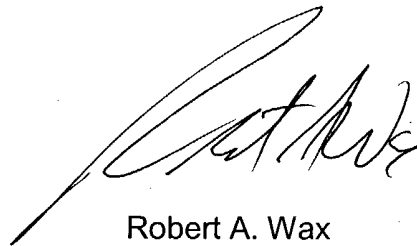
13. Claims 1, 4, 16, 17, 23, 26-34 and 37-43 are allowed. The prior art of record does not teach SEQ ID NO: 27, nor does it teach polynucleotides encoding other myocardin polypeptides, nor are segments of 1000 or 2000 nucleotides of SEQ ID NO: 27 taught.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Wax whose telephone number is (571) 272-0623. The examiner can normally be reached on Monday through Friday, between 9:00 AM and 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon P. Weber can be reached on (571) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Robert A. Wax', is positioned above the printed name.

Robert A. Wax  
Primary Examiner  
Art Unit 1653

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